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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,671	09/07/2000	Timothy Richardson	320043.00002	2152

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EXAMINER

FINEMAN, LEE A

ART UNIT PAPER NUMBER

2872

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/673,671

Applicant(s)

RICHARDSON, TIMOTHY

Examiner

Lee Fineman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 45, 46 and 48-74 is/are pending in the application.
- 4a) Of the above claim(s) 68-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45, 46 and 48-67, 74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/7/00 and 12/4/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office Action is in response to an amendment filed 4 December 2003 in which claims 45, 48, 52-53, 58 and 66 were amended, claim 74 was added and claims 1-44 and 47 were cancelled. Claims 45-46 and 48-74 are pending, of which claims 68-73 are withdrawn.

#### ***Drawings***

1. The replacement drawings for sheets 6 and 7 were received on 4 December 2003. These drawings are acceptable.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 58-59, 62 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al., U.S. Patent No. 5,296,669.

Regarding claims 58-59 and 62, Kobayashi et al. disclose in figs. 2 and 3 an apparatus for use with a microscope comprising a slide base (5) having a sample area (sunken portion with sample (2) in it) defined by a surrounding barrier (wall of sunken portion); at least one electrical conductor (8) integrated with the slide base (figs. 2 and 3), which traverses continuously through the sample area and has at least two electrical contacts (15) located outside of the sample area (figs. 2 and 3); wherein the at least one electrical conductor is disposed underneath the barrier (in

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so far as the bottom of the electrical conductor (8) in underneath the top of the barrier – see fig.

3) and wherein the at least one electrical conductor is sufficiently resistive to heat the sample area (column 3, lines 1-10).

Regarding claim 66, Kobayashi et al. disclose in fig. 3 an apparatus for use with a microscope comprising a slide base (5); a cover slip (14); a barrier formed on the surface of the slide base (sunken portion of 5 with sample (2) in it), the barrier surrounding a portion of the surface such that when the slide base and cover slip are engaged to form an assembled slide (Fig. 3) the barrier defines a sample area (sample (2) is within the barrier); and at least one electrical conductor (8) integrated with the slide base (fig. 3), which traverses continuously through the sample area and has at least two electrical contacts (15) located outside of the sample area (fig. 3)

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 45, 46, 48-57, 60-61, 63-65, 67 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. in view of Remy et al., U.S. Patent No. 4,231,660 and Van Den Bosch, U.S. Patent No. 3,482,898.

Regarding claims 45, 48-57, 60-61, 63-65, 67 and 74 Kobayashi et al. disclose the claimed invention except for an adhesive layer on a surface of at least one of said slide base and

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said cover slip, said adhesive layer surrounding a portion of said surface such that when said slide base and cover slip are engaged with said adhesive layer to form an assembled slide, said adhesive layer and said cover slip enclose and define a sealed sample, wherein at least one of said slide base and said cover slip includes at least two electrical conductors extending between said sealed sample area and a surface on at least one of said slide base and said cover slip outside said sealed sample area; and an insulating coating/layer, which is a dielectric coating and biologically and chemically inert, over the conductor within the sample area preventing any physical electrical contact with any sample. Remy et al. teaches a slide system/apparatus (fig. 2) for microscopy comprising a slide base (1) having a sample area defined by a surrounding barrier (fig. 2, column 4, lines 52-55); having many electrical conductors (2), integrated with the slide base, which traverses through or under the sample area and has at least two electrical contacts (10) located outside the sample area; wherein the electrical conductor is disposed underneath the barrier (fig. 2); an insulating coating, which is a dielectric coating and biologically and chemically inert, over the conductor within the sample area preventing any physical electrical contact with the sample (column 5, lines 17-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a dielectric coating of Remy et al. to the electrical conductor of Kobayashi et al. to insulate and provide damage protection for the electrical conductor. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have more than one electrical conductor in the system of Kobayashi et al. to provide more flexibility in the size and positioning of the sample.

Van Den Bosch teaches a slide system (figs. 1 and 2) for microscopy comprising a slide base (11 with 12); a cover slip (13); an adhesive layer (14) on a surface of at least one of said

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slide base and said cover slip, said adhesive layer surrounding a portion of said surface such that when said slide base and cover slip are engaged with said adhesive layer to form an assembled slide, said adhesive layer and said cover slip enclose a sealed sample area (fig. 1, column 3, lines 7-11), and wherein the adhesive layer is located on the slide base (fig. 1); and wherein at least one of said slide base and said cover slip includes at least two electrical conductors (15 and 16) extending between said sealed sample area and a surface on at least one of said slide base and said cover slip outside said sealed sample area (figs. 1 and 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add an adhesive layer between the cover slip and slide base around the defined barrier of Kobayashi et al. as suggested by Van Den Bosch to seal and protect the sample from adverse conditions (Van Den Bosch, column 3, lines 8-13). Therefore the two electrical conductors would extend between said sealed sample area and a surface on said slide base outside said sealed sample area.

Regarding claim 46, Kobayashi et al. in view of Remy et al. and Van Den Bosch disclose the claimed invention except for the rearrangement of one of the electrical conductors being on the cover slip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the electrical conductors, since it has been held that a mere rearrangement of an element without modification of the operation of the device involves only routine skill in the art. One would have been motivated to rearrange the electrical conductors for the purpose of providing more flexibility in the size and positioning of the sample. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

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***Response to Arguments***

6. Applicant's arguments with respect to claims 45-46, 48-67 and 74 have been considered but are moot in view of the new ground(s) of rejection.

7. It is noted by the Examiner that the objections to the specification and drawings made in the previous Office Action have been withdrawn due to amendment by the Applicant.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-23124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LAF  
March 1, 2004

  
MARK A. ROBINSON  
PRIMARY EXAMINER